

382.1031CON

REMARKS

Claims 1-4, 6, 7, 11 and 12 are pending in this application. Applicant has amended claim 1, canceled claim 4 and added new claim 21. After claim amendments, cancellations and additions herein, claims 1-3, 6, 7, 11, 12 and 21 will be pending.

In the final Office Action, the Examiner acknowledged Applicants' Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b) with regard to parent application Serial No. 09/763,117. Applicants advise the Examiner that the petition to revive parent application Serial No. 09/763,117 was granted for the purposes of establishing continuity of this application from parent application Serial No. 09/763,117, and attached hereto is a copy of the decision by the USPTO granting that petition. Applicants now respectfully request that the Examiner acknowledge Applicants' claim of priority from that application.

In the final Office Action, the Examiner also stated that the Oath and Declaration is defective because it recites a claim for priority from parent application Serial No. 09/763,117. Inasmuch as Applicants' claim for priority from that application has been reestablished, as discussed above, Applicants now respectfully request that the Examiner withdraw this rejection.

The Examiner also stated that claims 1-4, 6, 7, 11 and 12 remain rejected in modified form under 35 U.S.C. § 112, first paragraph, because the specification does not provide enablement for a transgenic mouse comprising a nucleic acid sequence encoding a trans-synaptic tracer protein operably linked to a neural promoter from any species other than mammalian, wherein the trans-synaptic tracer protein is expressed in neurons of interest. Applicants thank the Examiner for the courtesies extended during telephone conferences on January 31 and June 19, 2006, wherein the Examiner confirmed that addition of the word "mammalian" before "neuron specific promoter" in independent claim 1 would overcome this rejection. Accordingly, Applicants have so amended claim 1 and now request that this rejection be withdrawn.

The Examiner also maintained the rejections of claims 1-4 and 6, 7, 11 and 12 under 35 U.S.C. § 102(b) as being anticipated by International Application No. PCT/JP99/04439, filed August 18, 1999, from which this application claims priority, and as being anticipated by, and

382.1031CON

under 35 U.S.C. §103(a) as being obvious over, Yoshihara et al, A Genetic Approach to Visualization Neurotechnique of Multisynaptic Neural Pathways Using Plant Lectin Transgene, Neuron, Vol. 22, pages 33-41, (1999). In response, Applicants respectfully point out that the claim for priority of the instant application from parent application Serial No. 09/763,117 and from Japanese Patent Application No. 232817/1998, filed April 19, 1998, has been perfected, such that Yoshihara et al. is not prior art, as its the publication date (January 1999) occurs after the date of priority of instant application (April 19, 1998). Accordingly, Applicants respectfully request that this rejection be withdrawn.

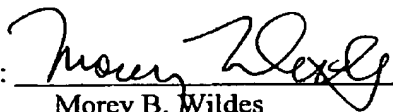
Applicants also note that they have detected an error in claim 4, which depends from and makes reference to claim 6. Accordingly, Applicants have canceled claim 4 and have added the identical claim as new claim 21.

Conclusion

In view of the amendments and arguments set forth herein, Applicant believes that all claims 1-3, 6, 7, 11, 12 and 21 are in condition for allowance. In the event that the Examiner determines that the application is not in condition for allowance, Applicant respectfully requests that the Examiner contact the undersigned for a telephone interview before another Office Action is issued in the application.

A favorable action on the merits is earnestly solicited.

Respectfully Submitted,
DAVIDSON, DAVIDSON & KAPPEL, LLC

By: 
Morey B. Wildes
Reg. No. 36,968

DAVIDSON, DAVIDSON & KAPPEL, LLC
485 Seventh Avenue, 14th Floor
New York, New York 10018
(212) 736-1940



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DAVIDSON DAVIDSON & KAPPEL
14TH FLOOR
485 SEVENTH AVENUE
NEW YORK NY 10018

RECEIVED
FEB 07 2006

COPY MAILED

FEB 02 2006

OFFICE OF PETITIONS

In re Application of
Yoshihiro Yoshihara
Application No. 09/763,117
Filed: February 15, 2001
Attorney Docket No. 382.1031

DAVIDSON, DAVIDSON & KAPPEL

ON PETITION

This is a decision on the renewed petition under 37 CFR 1.137(b)¹, filed December 15, 2005, to revive the above-identified application.

The petition is **GRANTED**.

A Final Office Action was mailed January 14, 2003 setting a three month shortened statutory period for reply. . No response or request for an extension of time having been filed in this application prior to the expiration of the time set for reply, this application became abandoned April 15, 2003. Accordingly, a Notice of Abandonment was mailed August 11, 2003.

A petition to revive was filed on October 24, 2005 wherein petitioner argued that a three month extension of time was filed, purportedly in response to the Final Office Action mailed January 14, 2003. In a decision mailed November 30, 2005, petitioners were advised that no such extension of time was found with the petition filed October 24, 2005 and, pursuant to 37 CFR 1.136, an extension of time must be filed prior to the

¹Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

COPY
1-224-1101

Application No. 09/763,117

Page 2

expiration of the maximum period obtainable for reply to avoid abandonment. Accordingly, the extension of time would not be a proper reply, after abandonment of an application, to any office action mailed and thus would be unnecessary. Finally, the decision advised that the only proper reply to a final Office action is an amendment placing the application in *prima facie* condition for allowance, a Notice of Appeal accompanied by the requisite fee, a Request for Continued Examination (RCE) accompanied by a proper submission, or a continuing application.

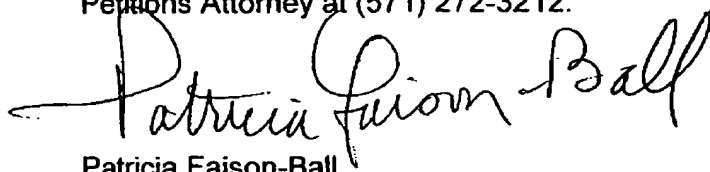
Petitioners now argue that continuation application no. 10/620,148 was filed July 14, 2003 in response to the Final Office Action mailed January 14, 2003, pursuant to 37 CFR 1.53(b).

A review of the file in application no. 10/620,148 reveals that the three month extension of time referenced in the petition to revive filed October 24, 2005 was incorrectly filed with the continuation and not the instant application. Thus, the instant application had no co-pendency with the continuation application.

In view thereof, continuity is now established by this decision reviving the application and since this application is being revived for purposes of continuity only, this application is again abandoned in favor of continuation application no. 10/620,148 filed July 14, 2003, pursuant to the provisions of 37 CFR 1.53(b).

This matter is being referred to Technology Center 1632 for processing of the continuation application filed July 13, 2003.

Telephone inquiries related to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.



Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

COPY